REMARKS/ARGUMENTS

The following remarks are submitted in response to the Office Action dated March 26, 2004. Reconsideration of the application in view of the following remarks is requested.

1. Claim Objections

Claim 41 was objected to because of certain informalities. Applicant has amended the claim 41 in accordance with the Examiner's suggestion and respectfully requests reconsideration of claim 41 in view of the amendment.

2. Claim Rejections - 35 U.S.C. §112

Claim 54 is rejected under 35 U.S.C. §112 first paragraph as failing to comply with the enablement requirement. Specifically, the Examiner states that claim 54 contains subject matter (i.e., wireless connection) which was not described in specification in such a way as to enable one skilled the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverses the Examiner's objection and directs the Examiner to page 6 line 20-26 where it is stated, "in addition to receiving travel related reservations from a travel agent, via a CRS, award system 16 can also receive travel-related reservations from other sources, such as the following examples: a phone (modem) link; an automatic teller machine; a kiosk, and an interactive television system." Applicant respectfully submits that at the time the application was filed wireless modems were a method of data transmission and while not included in the example in the methods of communications, based on the language of the specification wireless methods of data transmission are inherit and at the time the application was filed would be included in a list of methods of communicating. At the time the application was filed, Applicants identified interactive television system. An interactive television system as a means for data transmission is substantially more complex than wireless communication. In addition, while we did not identify the phone link as being hard wired at the

time the invention was filed, a phone link may have been a wireless link. In view of the specification on page 6 at lines 20-26, Applicant respectfully requests reconsideration of the rejection under 35 U.S.C. §112 first paragraph and a withdrawal of the rejection of claim 54.

3. Claim Rejections - Double Patenting

Claims 41-44, 46-48, 50-53 and 55-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,483,444. In accordance with 37 CFR 3.73(b), Applicant respectfully submits that it is the assignee of the present application, recorded at REEL/FRAME 011107/0880.

The present patent application and U.S. Patent No. 5,483,444 are commonly owned by Radisson Hotels International, Inc. Moreover, the present application is a continuation of S/N 09/598,586, filed June 21, 2000, which is a continuation of S/N 08/892,563, filed 7/14/1997, which is a file wrapper continuation of S/N 08/439,626, filed 5/12/1995, which is a continuation of S/N 08/385,381, filed 2/7/1995, which is a continuation of S/N 08/143,453, filed 10/26/1993. S/N 08/143,453 was abandoned in favor of S/N 08/385,381, which ultimately matured into U.S. Patent No. 5,483,444.

In addition, in accordance with 37 C.F.R. 1.321, a Terminal Disclaimer is submitted herewith to overcome this rejection. Appropriate fees for filing the Terminal Disclaimer should be taken from deposit account No. 13-2725.

4. Claim Rejections - 35 U.S.C. §103

The Examiner rejected claims 41-53 and 55-63 under 35 U.S.C. §103 as being anticipated by *Webber* (U.S. Patent No. 5,331,546) in view of the article *Which Frequent-Flier Program* (Consumer Reports Travel Letter: vol. 6, no. 10, pp. 112-116, October 1990). Applicants respectfully traverse the Examiner's rejections. In opposing the rejection, Applicant points to case law governing obviousness rejections.

The test for obviousness under 35 U.S.C. §103 is what the combined teachings of the references would have suggested to one of ordinary skill in the art. In re: Young, 927 F.2d 588, 591 (Fed. Cir. 1991). The test must take into consideration the invention as a whole, and include consideration of the results achieved by the combination. Gillette Co. v. S.C. Johnson & Son, 919 F.2d 720, 724 Fed. Cir. 1991. In reviewing the prior art references, the reviewer must "place themselves in the minds of those of ordinary skill in the relevant art at the time the invention was made, to determine whether that which is now plainly at hand would have been obvious at such earlier time." Interconnect Planning Corp. v. Feel, 774, F.2d 1132, 1143 Fed. Cir. 1985.

The Federal Circuit has confirmed the above-mentioned test by stating that "before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." In re: Jones 958 F.2d 347, 351(Fed. Cir. 1992). In the present case, there is no teaching, motivation or suggestion in the *Webber* '546 patent or *Which Frequent-Flier Program* that the references be combined.

The Federal Circuit has stated, "one cannot use hindsight reconstruction to pick and choose among isolated disclosure in the prior art to deprecate the claimed invention." In re: Frisch, 972 F.2d 1260, 1266 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." Id. There is no suggestion for the modifications required by the Examiner's combination of the *Webber* '546 patent and the *Which Frequent-Flier Program* article in either of the references. Moreover, even if the *Webber* '546 patent and the *Which Frequent-Flier Program* article are combined, the resulting system does not disclose a system or method that would include all of the claimed elements set forth in claims 41-53 and 55-63. The Examiner already admits that the *Webber* '546 patent does not disclose an award system. The *Webber* '546 patent also fails to disclose a reservation facility computer

system. (See page 9). The reservation facility computer system of the present invention is a computer system that is separate and distinct from a computerized reservation system and is claimed as such in independent claims 41, 47 and 59. This distinction is also set forth in the specification of the present invention pages 5-6. Specifically, on this point, the specification reads as follows:

> *A travel agent terminal 10 transmits the travel-related reservation to a computerized reservation system 12. Computerized Reservation Systems (CRS) are well known in the art and include, for example, CRS's known by the following trademarks and companies: AMADEUS; SABRE; WORLDSPAN; SYSTEM ONE; APOLLO; GEMENI; GALILEO; and AXESS.*
>
> *A CRS allows a travel agent or other person to enter a travel-related reservation in a particular availability format.*
>
> . . . .
>
> *A conversion system 14 receives an availability format, which identifies a travel-related reservation from CRS 12.*
>
> . . . .
>
> *Conversion system 14 can then transmit a booking format to a particular reservation facility 18. Reservation facility 18 may include, for example, a particular hotel, cruise ship line, or car rental company identified by a travel-related reservation contained within a booking format.*

The Examiner asserts that the *Webber* '546 patent discloses a reservation facility computer system at column 4, lines 5-25; column 9, lines 9-50. Applicant respectfully disagrees. What is disclosed in the *Webber* '546 patent at column 4, lines 5-25; column 9, lines 9-50 is a computerized reservation system, such as Apollo. Claims 41, 47 and 59 of the present application all disclose a computerized reservation system as one of its claimed elements. Further, at page 5 lines 28-33, the present patent application specifically identifies Apollo as one of the computerized reservation systems of which the present invention is comprised. Applicant acknowledges that the *Webber* '546 patent discloses a computerized reservation system. Notwithstanding, the *Webber* '546 patent lacks a reservation facility computer system, contrary to the Examiner's assertion. As set forth in the specification of the present application at page 6 lines 27-32, a reservation facility computer system may be a computer system of "a particular

hotel, cruise ship line, or car rental company identified by a travel-related reservation contained with a booking format." It is a computer system that is separate and distinct from a computerized reservation system. Moreover, the claimed reservation facility computer system is accessed by the claimed computerized reservation system. Accordingly, in view of the fact that the *Webber* '546 patent lacks a "reservation facility computer system, " it lacks a claimed element set forth in claims 41, 47 and 59.

Regarding the *Which Frequent-Flier Program* article, Applicant acknowledges that the article does disclose frequent-flier programs where people can earn credits in various ways, such as flying, staying at hotels, and renting cars. However, Applicant disagrees with the Examiner's assertion that the discussion in the *Which Frequent-Flier Program* article is sufficient to satisfy the element set forth in claims 41, 47 and 59 relating to an awards system connected to a network that is configured to receive data concerning travel related reservations. While there is a general discussion of award programs, there is no discussion of an awards system connected to a network that is configured to receive data concerning travel related reservations. Moreover, the Examiner acknowledges this point and does not assert that Webber discloses an awards system connected to a network, he simply asserts that because the article discusses frequent flier programs where people can earn credits in various ways, "it would have been obvious to a person of ordinary skill in the art at the time the application was made to know that a customer would use the Webber computerized system to book travel reservations and would use the Frequent-Flier program taught by the above article, to earn credits for Frequent-Flier points for miles flown or purchases made through partners airlines, car-rental companies, hotel chains, and credit-cards."

The *Which Frequent-Flier Program* article is nothing more than a summary of various award programs without any mention of an award system or manner in which the award programs are implemented. Applicant respectfully submits that the Examiner failed to satisfy the MPEP §702.02(j) because this section of the MPEP requires that the prior art references teach or suggest all the claim limitations. There is no teaching or suggestion of an awards system

connected to a network that is configured to receive data concerning travel related reservations. Moreover, to the extent there is a combination of the *Webber* '546 patent and the *Which Frequent-Flier Program* article, Applicants respectfully submit such a combination would be improper because there is no teaching or suggestion within either document to make the proposed combination. As the Federal Circuit has indicated, combining references is only proper when there is some teaching or suggestion to make the combination. See in re: Vaeck, 947 F.2d 488 Fed. Cir. 1991. Further, there must be some reasonable expectations of success with the proposed combination found in the prior art and not based on Applicants' disclosure. Id.

Even if it were proper to combine the *Webber* '546 patent and the *Which Frequent-Flier Program* article, the structure that would result from the Examiner's proposed combination does not meet the terms of claims 41-52 and 59-63. Accordingly, applicant respectfully requests reconsideration of the rejection of independent claims 41, 47 and 59 in view of the above comments and claims 42-46, 48-52 and 60-61 by virtue of their dependency on claims 41, 47 and 59. The reasons a combination of the *Webber* '546 patent and the *Which Frequent-Flier Program* article do not meet the terms of claims 41-52 and 59-63 is because the resultant system and structure necessary to implement the claimed system and method lacks a "reservation facility computer system" and "an awards system connected to a network that is configured to receive data concerning travel related reservations."

Regarding Claim 53, the Examiner asserts that the *Webber* '546 patent includes a computer implemented method that transmits a purchaser identification code and travel related purchase information via an interface device connected to a network to an award system connected to the network upon the completion of a travel related purchase. See page 16 of the Office Action Response. This assertion is directly contrary to the Examiner's contention set forth in pages 8-15 of the Office Action Response wherein the Examiner indicates that Webber fails to teach an award system connected to a network. Further, Applicant's respectfully submit that the *Webber* '546 patent does not include disclosure concerning a computer implemented method that transmits travel related data to an award system connected to a network.

The Examiner acknowledges that the *Webber* '546 patent fails to teach elements b and c of claim 53. The Examiner directs the Applicants to the *Which Frequent-Flier Program* article at paragraphs 5, 6, 9, 11, 17 and 47 to find elements b and c. Applicants respectfully submit that the entire *Which Frequent-Flier Program* article is nothing more than a summary of various frequent flyer award programs without any mention of system processing, operation or structure of the awards system. The Examiner simply indicates that the mention of frequent flyer programs in the *Which Frequent-Flier Program* article makes the present invention obvious to one of ordinary skill in the art. Processing step b requires the processing of travel related purchase information by the awards system to verify completion of travel related purchases are complete and then calculates the credit to be assigned to the person completing the travel related purchase. It takes a sophisticated award system to track completion of actual travel related purchases because the awards system has to be networked to the reservation facility computer system so that upon utilization of the reservation in completion of the travel related purchase, the awards system is notified and credits are awarded to the person completing travel related purchase. The *Which Frequent-Flier Program* article mentions nothing about an awards system being networked or the processing that occurs prior to and in order for credits to be assigned to the person completing the travel related purchase.

In view of the above comments, Applicants respectfully request reconsideration of claim 53. A combination of the *Webber* '546 patent and the *Which Frequent-Flier Program* article does not result in a system capable of performing a computer implemented method and processing steps set forth in steps a-c of claim 53. In addition Applicant's respectfully request reconsideration of claims 54 and 56-58 by virtue of their dependency on claim 53. Applicant's also hereby incorporate the arguments set forth above regarding claims 41-52 and 59-63 above in view of the fact that the computer implemented system necessary to perform the processing steps a-c set forth in claim 53 are not disclosed in the *Webber* '546 patent or the *Which Frequent-Flier Program* article.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,
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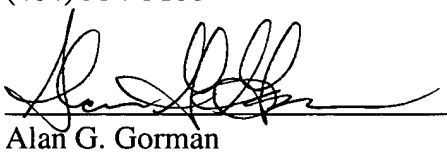

Date: September 27, 2004

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